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REMARKS

Applicants respectfully request entry of the Amendment filed on August 28, 2002 and entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended herein, pursuant to and consistent with 37 C.F.R. §1.116, and in light of the remarks which follow.

Upon entry of the Amendment filed on August 28, 2002, and the present Amendment, claims 33-44 will be pending in the application, claims 45-52 having been cancelled above.

By the above amendments, Applicants propose canceling claims 45-52, which were proposed to be added by the Amendment filed on August 28, in an effort to expedite allowance of the application.

Applicants thank the Examiner for returning their representatives' telephone calls regarding the status of the present application.

Additionally, Applicants thank the Examiner for the courtesies extended to their representatives (Martin Bruehs and Mary Katherine Baumeister) during the personal interview conducted on June 28, 2002. In particular, Applicants thank the Examiner for indicating that the compound and composition claims (now claims 33-44) would be allowable if amended to include re-worded proviso language to more clearly define the disclaimed combination of substituents R₂ and R₃.

Claims 12-13 and 19-23 stand rejected under 35 U.S.C. §102(b) as being anticipated by Obushak (DN 113:153 173, HCAPLUS; Abstract of Zh. Org. Hhin. (1990) 26(4), 873-

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80) and Krutosikova (DN 84:58390, HCAPLUS; Abstract of Collect Czech., Chem. Commun. (1975, 40) (11, 3362-9). As claims 12-32 have been cancelled, this rejection is now moot. However, as Applicants have proposed adding new claims 33-44 that correspond closely to cancelled compound and composition claims 12-32, Applicants provide the following remarks to again explain why new claims 33-44 are not anticipated by Obushak or Krutosikova.

As previously explained, the Abstract of Obushak and the Abstract of Krutosikova disclose compounds wherein $R_2 = H$ and $R_3 = O-Me$ and wherein $R_2 = O-Me$ and $R_3 = H$, respectively. However, as explained during the personal interview of June 28, and as set forth in proposed claims 33-44, these combinations are excluded from the claimed subject matter. That is, the following combinations are clearly excluded under the definition of proposed claims 33-44:

(a) $R_2 = R_3$ hydrogen; $R_2 = R_3 -OR_5$; $R_2 = R_3 = -SR_5$; when $R_2 =$ hydrogen, R_3 cannot equal $-OR_5$ or $-SR_5$; when R_2 equals $-OR_5$, R_3 cannot equal hydrogen or $-SR_5$; when $R_2 = -SR_5$, R_3 cannot be $-OR_5$ or hydrogen; when $R_3 =$ hydrogen, R_2 cannot be $-OR_5$ or $-SR_5$; when R_3 is $-OR_5$, R_2 cannot be hydrogen or $-SR_5$; and when R_3 is $-SR_5$, R_2 cannot be $-OR_5$ or hydrogen. Accordingly, the Abstract of Obushak and the Abstract of Krutosikova fail to disclose each and every element of the presently claimed invention.

Additionally, Applicants wish to again point out that the re-written proviso language with respect to the definition of substituents R_2 and R_3 does not constitute an addition of

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new matter because the re-written proviso merely clarifies the original language " R_2 and R_3 cannot at the same time be (i), (iii) and (iv)."

Accordingly, as Applicants have written the above new claims to include the re-written proviso language to more clearly define the excluded combinations of R_2 and R_3 , in accordance with the Examiner's instructions, Applicants submit that the presently claimed invention is not anticipated by Obushak or Krutosikova.

That is, as the Examiner herself agreed during the personal interview of June 28, because the combinations of R_2 being hydrogen and R_3 being methoxy and R_2 being methoxy and R_3 being hydrogen are explicitly excluded by the above proviso, the compounds of the presently claimed invention are NOT anticipated by either Obushak or Krutosikova, which describe compounds that fall within the excluded combinations. In particular, the Interview Summary states "claim 12 (which now corresponds to proposed claim 33) will be amended to make the proviso clear. In that case 102 will be withdrawn."

In summary, because proposed claims 33-44 correspond to original compound and composition claims 12-32, and because Applicants have rewritten these claims to include the re-worded proviso language that the Examiner herself indicated would overcome the only outstanding rejection of these claims, Applicants respectfully request that the Examiner withdraw the §102 rejection over Obushak and Krutosikova and allow the application.

With respect to the 35 U.S.C. §112, first paragraph, rejection of claims 16-18, as these claims have been cancelled, this rejection is now moot. In addition, as Applicants

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have now canceled proposed method claims 45-52, any issues the Examiner may have had with respect to the method claims are moot. In particular, because Applicants have proposed canceling method claims 45-52, the only claims that are now pending are the proposed compound and composition claims 33-44. Because the Examiner has already searched and examined the subject matter of these claims and indicated that they would be allowed once amended to include the above re-worded proviso language, Applicants submit that the Examiner cannot now take the position that claims 33-44 "require further consideration."

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

Should the Examiner have any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
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Date: December 31, 2002

Attachment: June 28, 2002 Interview Summary

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Interview Summary

Application No.

09/619,584

Applicant(s)

Bernarden et al.

Examiner

Sabiha Qazi

Art Unit

1616

All participants (applicant, applicant's representative, PTO personnel):

(1) Sabiha Qazi, Ph.D. (Examiner)(3) Martin Bruehs (Attorney) Reg. No. 45635 **MAB**(2) Marry Beumeister, Reg. No. 26254 **KB**

(4) _____

Date of Interview Jun 28, 2002Type: a) ☐ Telephonic b) ☐ Video Conferencec) ☒ Personal [copy is given to 1) ☐ applicant 2) ☒ applicant's representative]Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No. If yes, brief description:Claim(s) discussed: All claims

Identification of prior art discussed:

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The interview was done on the records of Mr. Bruehs record. All claims were discussed in detail. Claim 12 will amended to make the proviso clear. In that case 102 will be withdrawn. Rejection under 112 is maintained. Applicant will amend the claims and will write steps involved in methods as well as the treatment which are supported by the disclosure.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☐ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached

SABIHA QAZI
PRIMARY EXAMINER
ART UNIT 1616

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required